



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/722,144	12/12/96	ISHIGURO M	2292-038-U

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EXAMINER

BERCH, M

ART UNIT

1611

PAPER NUMBER

DATE MAILED: 03/08/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory ActionApplication No.
08/722,144Applicant(s)
IshiguroExaminer
Mark L. BerchGroup Art Unit
1611**THE PERIOD FOR RESPONSE:** [check only a) or b)]

- a) ☐ expires _____ months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on Feb 17, 1999 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Feb 17, 1999 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):

☒ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☐ will not be entered because:

- ☐ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

- ☒ Applicant's response has overcome the following rejection(s):

Alfonso and Menard for some claims; see detailed action

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Detailed Action

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: 35

Claims rejected: 1-29, 32-34, and 37-68

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.

- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

- ☐ Other

MARK L. BERCH
PRIMARY EXAMINER
ART UNIT 1611

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DETAILED ACTION

The traverse over EP 69373 is unpersuasive. A racemate does indeed anticipate a specific enantiomer. In general, a claim to A is anticipated by a mixture of A + B, regardless of whether B is air, a pharmaceutical carrier, or a stereoisomer of A; the examiner knows of no case to the contrary. Purity limitations are not read into claims, *In re Kebrich*, 96 USPQ 411. Applicants' compounds is old. If Claim 1 were patented, surely applicants would consider a mixture of Claim 1 with anything to be an infringement of the claim. Even if it didn't, with three optical centers, there are 8 possible isomers, and a genus of 8 anticipates every member, *In re Petering*, 133 USPQ 275. As for "actually synthesized", that is legally irrelevant. The exact compound is named on page 11. As noted previously, the exact configuration is set out on the reference. With regard to a "correlation between cis configuration and activity", this is not relevant for an anticipation.

Narrowing R₁ would overcome Alfonso and Menard, except for Claims 37, 66 and 67, which were not so narrowed.

The traverse over Girjavallabhan is not entirely understood. The relevant compound is (23); compound (14) is not. The fact that (14) was analyzed in human serum, etc, has nothing to do with the patentability of the claims over (23).

The same is true for Ishiguro. The actual ones tested are the hydroxy ethyl, but as noted previously, the reference teaches hydroxy alkyl generally, rendering the C₁ - C₄ alkyls all obvious as set forth in the first action. The reference does not have to

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provide a problem to be solved in order to render the claims structurally obvious (this applies to Leanza as well). As for Sunagawa, applicants argue that the claimed configuration is not preferred. This is true. But it is disclosed. A reference is available for all that it teaches, not just the best or even the preferred embodiments. In this regard, see *In re Lamberti*, 192 USPQ 278, 280; *In re Boe*, 148 USPQ 507, 510; *In re Fracalossi*, 215 USPQ 569, 570. The same is true for the fact that in Leanza, only a trans form has the 1-hydroxypropyl as preferred. Both features are clearly present in the reference, the configuration and the 1-hydroxypropyl. That they don't appear in the same molecule simply means that the reference is not an anticipation, not that it doesn't render the claims obvious.

No PTOL 1449 has been prepared for the reference because the copy provided had no volume or page numbers on it, and so it cannot be properly cited.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718.



Mark L. Berch

Primary Examiner

Group 1610 - Art Unit 1611

March 5, 1999